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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,641	01/03/2001	David Proulx	0007056-0062/P5334NP/ARG	7529

26263 7590 05/21/2004

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EXAMINER

SCHLAIFER, JONATHAN D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/756,641	Applicant(s) PROULX ET AL.	
	Examiner Jonathan D. Schlaifer	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to application 09/756,641 filed on 1/3/2001, with prior art filed 8/5/2003.
2. Claims 1-21 are pending in the case. Claims 1, 8 and 15 are independent claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7, 14, 21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the inventions. It is unclear whether the individual characters are stored in a multi-byte format or the whole group of characters is stored in a multi-byte format. For purposes of examination, the Examiner has chosen to assume that the whole group of characters is to be stored in the multi-byte format.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The method cited lacks a concrete technological basis and could potentially be performed by a human being using pencil and paper. This rejection

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could be overcoming by specifically stating that the method is performed on a computing device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1, 5-6, 8, 12-13, 15, and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Fein et al. (USPN 6,088,711—filing date 7/1/1997), hereinafter Fein.**
6. **Regarding independent claim 1**, Fein discloses a method for compactly storing a word processing document (col. 1 of the patent describes how word processing documents are stored) comprising: storing a set of styles associated with said word processing document (storing styles is described in col. 1, lines 25-35); storing a set of text information associated with said word processing document (the text is marked with styles in col. 1, lines 25-50; this inherently requires storing the text); storing a set of linking information that links said set of text information and said set of styles (the text is marked with styles in col. 1, lines 25-50; this inherently requires storing linking information).
7. **Regarding dependent claim 5**, Fein discloses storing said set of styles in a first record (in col. 1, lines 25-40, Fein discusses defining and storing styles).

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8. **Regarding dependent claim 6**, Fein implies storing said set of text information and said set of linking information in one or more second records (see col. 1, lines 50-55, the document is associated with a template, which implies storing the text and linking information in order to bring about the association.)
9. **Regarding independent claim 8**, it is a word processing document compactor that performs the method of claim 1, and is similarly rejected under the same rationale.
10. **Regarding dependent claim 12**, it is a word processing document compactor that performs the method of claim 5, and is similarly rejected under the same rationale.
11. **Regarding dependent claim 13**, it is a word processing document compactor that performs the method of claim 6, and is similarly rejected under the same rationale.
12. **Regarding independent claim 15**, it is a computer program product that performs the method of claim 1, and is similarly rejected under the same rationale.
13. **Regarding dependent claim 19**, it is a computer program product that performs the method of claim 5, and is similarly rejected under the same rationale.
14. **Regarding independent claim 20**, it is a computer program product that performs the method of claim 6, and is similarly rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 2-4, 9-11, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fein, further in view of Microsoft Corporation, Microsoft Word: User's Guide, 1993-1994, Microsoft Corporation, Version 6.0, Pages 114 and 133, hereinafter Microsoft Corporation.**
16. **Regarding dependent claim 2**, Fein fails to disclose that said set of styles is divided into a first gallery and a second gallery. However, Microsoft Corporation, on pages 114 and 133, reveals that style for Microsoft Word is manipulated via two galleries, Paragraph and Font. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used two galleries in the manner of Microsoft Word in the invention Fein because this is a more convenient, logically designed scheme for the user, because Paragraph formatting options and Font formatting options were grouped that way in Microsoft Word because they affect different scope levels of the document.
17. **Regarding dependent claim 3**, Fein fails to disclose that said set of styles is divided into a first gallery and a second gallery. However, Microsoft Corporation, on pages 114 and 133, reveals that style for Microsoft Word is manipulated via two galleries, Paragraph and Font. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used a first Paragraph gallery in Fein in the manner of Microsoft Word because this is a convenient, logically designed scheme for the user as indicated in the rejection for claim 2.
18. **Regarding dependent claim 4**, Fein fails to disclose that said set of styles is divided into a first gallery and a second gallery. However, Microsoft Corporation, on pages 114 and 133, reveals that style for Microsoft Word is manipulated via two galleries, Paragraph

and Font. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used a second Font (text style) gallery in Fein in the manner of Microsoft Word because this is a convenient, logically designed scheme for the user as indicated in the rejection for claim 2.

19. **Regarding dependent claim 9**, it is a word processing document compactor that performs the method of claim 2, and is similarly rejected under the same rationale.
20. **Regarding dependent claim 10**, it is a word processing document compactor that performs the method of claim 3, and is similarly rejected under the same rationale.
21. **Regarding dependent claim 11**, it is a word processing document compactor that performs the method of claim 4, and is similarly rejected under the same rationale.
22. **Regarding dependent claim 16**, it is a computer program product that performs the method of claim 2, and is similarly rejected under the same rationale.
23. **Regarding dependent claim 17**, it is a computer program product that performs the method of claim 3, and is similarly rejected under the same rationale.
24. **Regarding dependent claim 18**, it is a computer program product that performs the method of claim 4, and is similarly rejected under the same rationale.
25. **Claim 7, 14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fein**
26. **Regarding dependent claim 7**, Fein fails to explicitly disclose storing one or more characters of said set of text information in a multi-byte format. However, Fein discloses that a document is stored (col. 1, line 50). Since the document would have potentially contained more than one character's worth and therefore one byte's worth of information

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it would have been obvious to one of ordinary skill in the art at the time of the invention to store the document in a multi-byte format because this would have been necessary for the storage of the document.

27. **Regarding dependent claim 14**, it is a word processing document compactor that performs the method of claim 7, and is similarly rejected under the same rationale.
28. **Regarding dependent claim 21**, it is a computer program product that performs the method of claim 7, and is similarly rejected under the same rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 5,802,533 (filing date 8/7/1996)—Walker

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS



STEPHEN S. HONG
PRIMARY EXAMINER